

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Seres et al

S.N.: 09/218,308

Filed: 12/22/1998

For: Protective Cover for Printers

A.U. : 2854

Examiner: Nguyen

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APPEAL BRIEF

Applicant, by and through the undersigned attorney, hereby appeal the final rejection of claims 23 - 68 in the Office Action mailed out on March 08, 2002. A Notice of Appeal was timely filed in this application on July 25, 2002. The Appeal Brief is thus filed within two months of the Notice of Appeal pursuant to 37 C.F.R. 1.191. The requisite fee under 37 C.F.R. 1.17(f) is enclosed.

Real Party In Interest

This application is presently owned by Inform Technologies LLP as assigned by the inventors.

Related Appeals and Interferences

There are no related appeals or interferences known to appellant that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status of Claims

Claims 1-4, 6, 8 - 16 and 18 - 21 are pending in this application. Claims 1- 4, 6 and 8 - 10 are presently under final rejection. Claims 11 - 16 and 18 - 20 are allowed. Claim 21 is objected to.

Status of Amendments

No amendments have been submitted with this appeal. The last amendment in this application was filed on December 26, 2001 which was entered.

Summary of the Invention

The claimed inventions relate to the field of protective covers for dispensing devices such as printers and point of sale terminals and particularly to the field of protective covers for dispensing devices in hostile environments. The protective cover includes a separate enclosure. The enclosure is simply placed over the dispensing device to be protected. This enclosure includes a dispenser which is placed adjacent and over the document feed path opening of the dispensing device. The dispenser includes a top portion, which in one preferred embodiment, is angled upward. The top portion extends over an access opening which is over the document feed path opening of the dispensing device. In use, the enclosure protects the dispensing device and in particular the document feed path opening of the dispensing device from the environmental contaminants, such as grease, oil, moisture and airborne food particles. The documents are dispensed from the dispensing device through the document feed path opening. The dispensed document is guided through the access opening of the enclosure by the angled top portion. The dispensed document is then easily retrieved. The enclosure is formed from a transparent, durable material which is preferably dishwasher safe.

Issues

1. Whether claims 1-4, 6 and 18 - 10 are unpatentable under 35 U.S.C. §103(a) over each of the patents to Frick (US 3,747,735) and Otsubo (JP 404,358,869).

Grouping of Claims

The above single issue was framed by the Office Action mailed on March 8, 2002.

Argument

Issues 1.

The Office Action of March 7, 2002 stated that:

"Each of the patents to Frick and Otsubo teaches a protective device which renders obvious the structure as broadly claimed. Frick teaches a protective device 7 having a hood 8 covering a document feed path opening, and an access opening 11 that allows the document 12 to be fed out as shown in Fig. 1. Otsubo teaches a protective device having a hood 1a which covers the document feed path opening and an access opening 7 for providing access to the document 5 which is just printed from a print device as shown in Figs. 1-7 and 9 of Otsubo. ***Each of the patents to Frick and Otsubo fail to clearly teach the protective device airborne particles.*** However one of ordinary skill in the art would have used the protective device which reduces noise of Frick or Otsubo (soundproof protective device) for protecting dispensing devices or printers from airborne particles or dust or environmental contamination. With respect to claims 3 and 4, the protective device 7 of Frick appears to be integral part of the printer, and the device is secured by means 6 to the cover or housing 5. With respect to claim 6, the hood of Frick having an angle top portion at the numeral reference 10 in Fig. 1. of Frick. with respect to claims 8, and 9, the selection of a desired material which is transparent or dishwasher safe involves only an obvious matter of design choice based upon obvious experimentation." (emphasis added)

The Office Action further stated that:

"Frick teaches a protective device including a hood which is an integral part of printer for covering a document feed path opening (the feed path is not clearly shown but the paper is fed out the access opening 11, Fig. 1 of Frick). While the protective cover of Frick is used for reducing noise from the printer, one of ordinary skill in the art would have been recognized that it protects the printer from dust or environmental contamination."

The Office Action further stated in response to Applicant's argument that the protective devices of each of the patents to Frick and Otsubo fails to teach the protective cover for airborne particles since Frick and Otsubo do not concern with environmental contamination that:

"This argument is not persuasive since Frick concerns with the disturbing sound and obviously, Otsubo concerns with the sound from a printer to make the

protective cover as explained above. The Examiner position is that the protective cover as taught by Frick or Otsubo that can protect an environment from disturbing sound, can also protect the environment from airborne particles. Therefore, there is no apparent unobviousness in the structure as recited relative to the structure of the prior art as applied.

Claim 1 as presently pending is directed to a protective device having a hood with an upper portion that extends over the document feed path opening of the dispensing device. This upper portion prevents contamination of the document feed path opening by airborne particles. The device also has an access opening on the hood that is spaced from the document feed path opening to allow documents to provide access to documents received from the dispensing device.

The standard to establish obviousness under 35 U.S.C. 103 has been defined by the CCPA and the CAFC to require: One or more references that were available to the inventor and that teach a suggestion to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. This standard has been set forth in numerous cases, including *W.L. Gore & Associates, Inc. V. Garlock, Inc.*, 220 USPSQ 303, 312-13 (Fed. Cir. 1983) *cert. denied*, 469 U.S. 851 (1984); *In re Fritch*, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992); and many others.

Thus, the Examiner **must** provide an (1) **actual teaching** that (2) **suggests** modifying the "protective device" of Frick and/or Otsubo (3) that would appear to be **sufficient to have made the claimed invention obvious to one of ordinary skill in the art**.

The Office Action acknowledged that neither reference taught or suggested the protective device (for) airborne particles. Instead, the Office Action merely states that "one of ordinary skill in the art would have used the protective device which reduces noise of Frick or Otsubo (soundproof protective device) for protecting dispensing devices or printers from airborne particles or dust or environmental contamination". The Office Action failed to provided the actual teaching or suggestion required by the CAFC to suggest using the soundproofing features of Frick or Otsubo to protect the printer from contamination by airborne particles. Neither Frick or Otsubo is the least concerned with environmental contamination. There is simply no suggestion or teaching in Frick or Otsubo to modify their devices to prevent contamination by airborne particles.

Frick discloses a sound insulating hood for noise emitting apparatus. This hood utilizes one or more sound insulating layers to lower the sound level outside the hood. There simply is no suggestion or teaching in this reference to protect the printer from anything. The sole purpose of the apparatus disclosed in this reference is to minimize sound transmissions. The disclosed device does have a cover 5 with a Plexiglas window that includes a slot 11 for paper to pass through from the printer. However, there is no disclosure, suggestion or teaching of protecting the printer document path from contamination by airborne particles.

Otsubo discloses a sound-proof case for packing printers. The entire purpose of this product is to improve a soundproof effect. There is no discussion, suggestion, or teaching of protecting the printer from airborne particles or any other type of contamination. Otsubo does appear to have an opening in the rear of the soundproof case to allow discharge of documents from the printer. This opening is directly over the printer paper discharge and would not prevent contamination to the printer document path from airborne particles. Further, there simply is no discussion for preventing contamination from airborne particles.

The Examiner, in the response to Applicant's prior arguments, dismissed the Applicant's arguments that Frick and Otsubo fail to disclose the claimed invention. The Examiner stated that "While the protective cover of Frick is used for reducing noise from the printer, one of ordinary skill in the art would have been recognized that it protects the printer from dust or environmental contamination." 35 U.S.C. 103 requires that there be an **actual teaching** that **suggests** modifying the structure of Frick or Otsubo in order to render the claimed invention obvious. The Examiner is not allowed to engage in impermissible hindsight in order to form that suggestion. This was clearly set forth in numerous cases, including *W.L. Gore & Associates, Inc. V. Garlock, Inc.*, 220 USPSQ 303, 312-13 (Fed. Cir. 1983) *cert. denied*, 469 U.S. 851 (1984).

Thus, the issue before the Board here is whether it would have been obvious to one skilled in the art at the time of the invention to modify a soundproof cover for a printer by extending an upper portion of a hood over the document feed path opening to prevent contamination of the document feed path opening by airborne particles and to provide an access opening spaced from the document feed path opening.

The Court of Appeals for the Federal Circuit has clearly ruled on the present issue. It is not enough that the product disclosed in Frick and/or Otsubo could have been modified to

include provide the specific structure set forth in claim 1 (an upper portion of a hood extending over the document feed path of the printer with an access opening spaced from the document feed path of the printer). There must be an actual teaching to suggest modifying the disclosure of Frick and/or Otsubo to modify their structures to provide these specific limitations for the purpose of protecting the document feed path opening from contamination by airborne particles. As stated by the Federal Circuit in *In re Fritch*, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992), "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." This is the situation here.

It is necessary that Frick and or Otsubo expressly suggests such limitations, or as the Federal Circuit stated in *Rockwell Int'l Corp. v. United States*, 47 USPQ 2d 1027, 1033 (Fed. Cir. 1998) "the consistent criterion for determination of obviousness whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success." In this instance, there is not suggestion of a hood having an upper portion extending over the document feed path opening to protect the document feed path opening from contamination by airborne particles and to provide an access opening spaced from the document feed path opening of the printer. Thus, claim 1 is not obvious under 35 U.S.C. 103 in view of Frick and/or Otsubo.

Claim 6 further includes the above limitations of claim 1 as well as the additional limitation of an angled top portion on the hood to guide the documents from the document feed path of the dispensing device into the access opening. Neither Frick or Otsubo disclose, suggest or teach this limitation. The soundproof cover of Frick discusses only a slot 11 in the lid 8 for the paper to pass through. The cover of Otsubo discloses only an opening in the packing case adjacent the printer discharge opening. Neither of these references disclose, suggest or in anyway teach the use of an angled top portion to guide the documents from the printer. Thus, claim 6 must be patentable over either or both of Frick and Otsubo.


Claims 2 – 4 and 8 - 10 stand and fall with claim 1

Summary

Claims 1 - 4, 6 and 8 - 10 are patentable over the cited prior art for the reasons stated above. The Applicant respectfully requests that the final rejection of these claims be reconsidered and these claims be allowed over the prior art. Claim 21 will also be patentable as dependent from claim 1. Claims 11 - 14 and 16 - 20 have already been indicated as allowable.

Respectfully submitted,

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Appendix

Claims

1. (rejected) A protective device for dispensing devices which have a document feed path opening for dispensing printed documents, said protective device comprising:

a hood having an upper portion extending over the document feed path opening to prevent contamination of the document feed path opening by airborne particles; and

an access opening on said hood spaced from the document feed path opening to allow documents to provide access to documents received from the dispensing device.

2. (rejected) The protective device of claim 1 wherein said means for covering at least the document feed path opening of the dispensing device includes:

a separate enclosure for mounting over the dispensing device.

3. (rejected) The protective device of claim 1 wherein said protective device further includes:

said protective device is an integral part of the dispensing device.

4. (rejected) The protective device of claim 1 wherein said protective device further includes:

said protective device is secured to a portion of a cover assembly of the dispensing device.

5. (canceled) The protective device of claim 1 wherein said means for covering at least the document feed path opening of the dispensing device includes:

a hood forming an enclosure over the document feed path opening and opening into said means for providing access.

6. (rejected) The protective device of claim 1 wherein said hood also includes:

an angled top portion to guide the documents from the document feed path of the dispensing device into said means for providing access.

7. (canceled) The protective device of claim 5 wherein said hood includes:
a top portion; and
a groove extending towards the document feed path opening of the dispensing device to guide the dispensed document.

8. (rejected) The protective device of claim 1 wherein said protective device includes:
at least a portion of said protective device is formed from a transparent material.

9. (rejected) The protective device of claim 1 wherein said protective device includes:
said protective device is formed from a material that is dishwasher safe.

10. (rejected) The protective device of claim 1 wherein the dispensing device includes:
a printer.

11. (allowed) A protective device for protecting a dispensing device having a document feed path opening for dispensing documents from environmental contamination, said protective device comprising:

an enclosure extending over the document feed path opening of the dispensing device;
a top panel on said enclosure;
at least one groove extending downward in said top panel on said enclosure;
means for securing said enclosure adjacent the document feed path opening of a dispensing device to cover the document feed path opening; and
an access opening in said enclosure and extending away from the document feed path opening of the dispensing device.

12. (allowed) The protective device of claim 11 wherein said means for securing said enclosure includes:

means for securing said protective device to a cover assembly on the dispensing device adjacent the document feed path opening of the dispensing device.

13. (allowed) The protective device of claim 11 wherein said means for securing said enclosure includes:

said protective device is an integral portion of the cover assembly of the dispensing device.

14. (allowed) The protective device of claim 11 wherein said means for securing said enclosure includes:

a separate enclosure which mounts over the dispensing device.

15. (allowed) The protective device of claim 11 wherein said enclosure includes:

means on said enclosure for guiding a document from the document feed path opening of the dispensing device through said access opening.

16. (allowed) The protective device of claim 15 wherein said means for guiding a dispensed document includes:

an angled top panel on said enclosure.

17. (canceled) The protective device of claim 15 wherein said means for guiding a dispensed document includes:

at least one groove extending downward in a top panel on said enclosure.

18. (allowed) The protective device of claim 11 wherein said protective device further includes:

at least a portion of said protective device being transparent.

19. (allowed) The protective device of claim 11 wherein said protective device further includes:

said protective device being formed from a dishwasher safe material.

20. (allowed) The protective device of claim 11 wherein the dispensing device includes:

a printer.

21. (objected) The protective device of claim 1 wherein hood includes:

a groove extending towards the document feed path opening of the dispensing device to guide the produced document.